

### **REMARKS**

In the Office Action dated September 4, 2008, the following rejections are present: claim 11 stands rejected under 35 U.S.C. § 112 (1); claim 18 stands rejected under 35 U.S.C. § 103(a) over the McKissick reference (US Patent Pub. No. 2007/0124795) in view of the Danker reference (US Patent Pub. No. 2003/0208777); claims 1-17 and 19-28 stand rejected under 35 U.S.C. § 103(a) over McKissick and Danker in view of the Oshita reference (US Patent No. 5,796,441); and claims 29-31 stands rejected under 35 U.S.C. § 103(a) over McKissick in view of Oshita. Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant respectfully traverses the § 103(a) rejections based on the McKissick reference in view of the Danker reference because the Examiner fails to provide a valid reason for the proposed combination. This approach is contrary to the requirements of Section 103 and relevant law. *See, e.g., KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007) (“A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.”). In this instance, the Examiner asserts that the skilled artisan would be motivated to modify McKissick with the cited teaching of Danker “for the purpose of allowing the transportation of the messages through the cable distribution infrastructure with regular television programming, which avoids the need to include extra transmission mediums.” The McKissick reference, however, already eliminates the need for additional communications paths that are physically separate from the paths that carry the television signal broadcast channels for the transmission of messages. *See, e.g.,* paragraph 0013. As such, the Examiner appears to be modifying the McKissick reference to address a problem that is already solved by McKissick. The requirement for providing a sufficient reason to combine references has been explained in specific examples through USPTO Board decisions and, in one such decision, the USPTO Board has opined that there is no proper motivation to combine where the alleged purpose for combining is to address a problem that the prior art has already addressed. *See, e.g.,* [www.iptoday.com/articles/2007-09-nowotarski.asp](http://www.iptoday.com/articles/2007-09-nowotarski.asp), which discusses numerous Board decisions in which Examiners’ rejections were overturned, in view of *KSR*, due to lack of a sufficient reason to combine.

Thus, as explained in such recent decisions, it is improper to combine references without any real motivation such as here, where a nonexistent problem is being addressed by the Examiner. As the Examiner fails to provide a valid reason for the proposed combination, Applicant submits that the Examiner has simply identified elements and appears to be improperly arranging these elements using Applicant's invention as a template through a hindsight reconstruction of Applicant's claims. *See, e.g.*, M.P.E.P. § 2142. Accordingly, the § 103(a) rejections based on McKissick in view of Danker are improper and Applicant request that they be withdrawn.

Applicant respectfully traverses the § 103(a) rejections based on the McKissick reference in view of the Oshita reference because Applicant submits that the combination of McKissick and Oshita is improper and would not function properly. According to M.P.E.P. § 2143.01(V), if "the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." In this instance, the relied upon portions of the Oshita reference teach providing data (*i.e.*, teletext data) from a central office to remote displays during the vertical blanking interval (VBI). *See, e.g.*, Col. 1:39 to Col. 2:5. Applicant respectfully submits that the teletext data is taught to be a broadcast message, and thus, is not specifically targeted toward a destination set top box. Thus, the use of Oshita would frustrate the messaging aspects of McKissick because neither reference suggests that Oshita's transmission mechanism would be suitable for targeted messages. Applicant submits that use of the broadcast-related data transmission techniques taught by the Oshita reference would result in text messages being received and displayed by more than the intended destination and frustrate a purpose of the McKissick reference (*i.e.*, sending data to a specific set top box).

Moreover, the only support in the record for providing targeted messaging between set top boxes using an output transport stream, such as MPEG-2 format, is found in Applicant's specification. For example, claim 2 explicitly calls out limitations directed to assigning a reserved program identifier to the data packets. Certain embodiments of Applicant's invention allow for an otherwise-broadcast related transmission to include targeted messages (*e.g.*, by allowing the destination boxes to select packets based upon

reserved program identifiers). The combination of the McKissick and Oshita references proposed by the Examiner fails to show correspondence to such limitations.

In view of the above, the § 103(a) rejections based on McKissick in view of Oshita are improper and Applicant requests that they be withdrawn.

Applicant respectfully traverses the § 112(1) rejection of claim 11 because aspects of the claimed invention directed to receiving another text message from another source set top box are fully supported by Applicant's disclosure. *See, e.g.*, Figure 1 and paragraph 0031. According to M.P.E.P. § 2163 (I), the written description requirement is satisfied with a showing that patent specification, as originally filed, describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention, and it is well accepted that a satisfactory description may be in the claims or "any other portion" of the originally filed specification including "such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention." Notwithstanding, in an effort to facilitate prosecution, Applicant has amended claim 11 to refer to a text message from another source set top box as suggested by the Examiner. Thus, Applicant submits that § 112(1) rejection of claim 11 is moot and Applicant requests that it be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9068.

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